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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/925,758	08/09/2001	Lawrence Oskielunas	8567.57US02	4841

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COHEN PONTANI LIEBERMAN & PAVANE LLP  
551 Fifth Avenue, Suite 1210  
New York, NY 10176

EXAMINER
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NGUYEN, NGA B

ART UNIT	PAPER NUMBER
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3692

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/925,758	<b>Applicant(s)</b> OSKIELUNAS ET AL.	
	<b>Examiner</b> Nga B. Nguyen	<b>Art Unit</b> 3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12-37, 39-48, 52-73 and 75-107 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-37, 39-48, 52-73 and 75-107 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This Office Action is in response to the communication filed on April 29, 2009, which paper has been placed of record in the file.
2. Claims 1-10, 12-37, 39-48, 52-73, and 75-107 are pending in this application.

### ***Response to Arguments/Amendment***

3. Applicant's arguments with respect to claims 1-10, 12-37, 39-48, 52-73, and 75-107 have been fully considered but are moot in view of new grounds of rejection.
4. Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-10, 12-37, 39-48, 52-73, and 75-107 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-10, 12-37, 39-48, 52-73, and 75-107 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to a machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps fail the first prong of the new Federal Circuit decision since they are not tied to a machine and can be performed without the use of a particular machine. It is unclear that whether "the exchange system" recited in the

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claims is software system or hardware system, it could be software system alone. Thus, claims 1-10, 12-37, 39-48, 52-73, and 75-107 are non-statutory since they may be performed within the human mind.

*The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101.*

Note the Board of Patent Appeals Informative Opinion Ex parte Langemyer et al.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-10, 12-37, 39-48, 52-73, and 75-107 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coyle, U.S. Patent No. 6,269,157, in view of Gros et al (hereinafter Gros), U.S. Patent Application Publication No. 2002/0004788.

Regarding to claim 1, Coyle discloses a method of auctioning data services in a network environment including an exchange system including a supplier list having at least one supplier and a buyer list having at least one buyer, the method comprising:

receiving in the exchange system a service request from a buyer for data services; and incentive data from a supplier on the supplier list to supply the data services (*column 26, line 60-column 27, line 35, Moderator receives request for future*

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*service (RFS) from buyers; column 7, lines 45-60, Moderator receives bids from carriers; column 11, lines 20-45);*

determining, at the exchange system, a selected supplier from the supplier list based on the incentive data (*column 7, lines 63-67, Moderator processes bids to prioritize them for each route*);

creating routing data at the exchange system for the data services to be routed through the selected supplier (*column 8, lines 1-10*); and

routing the data services through the selected supplier using the routing data created at the exchange system (*column 8, lines 10-45*); and

whereby data services are provided in an incentive-driven environment, allowing flexibility in supplier relationships for the buyer and providing improved utilization and yield management opportunities for the selected supplier (*column 2, lines 1-65*).

Coyle does not disclose tracking bandwidth utilization for the supplier to ensure that the supplier does not provide further incentive data for data services beyond the available bandwidth of the selected supplier. However, Gros discloses tracking bandwidth utilization for the supplier to ensure that the supplier does not provide further incentive data for data services beyond the available bandwidth of the selected supplier (*paragraphs [0038], [0043], [0083]-[0085], the pooling point administrator monitors of the quality of service of delivered bandwidth to ensure that it meets the contracted for terms*). Therefore, it would have been obvious to one with ordinary skill in the art to modify Coyle's to adopt the features taught by Gros's above, for the purpose of ensuring

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that the supplier does not provide further incentive data for data services beyond the available bandwidth of the selected supplier.

Regarding to claim 2, Coyle further discloses wherein data services include at least one of data transportation services and data application service (*column 7, lines 30-45*).

Regarding to claims 3-7, Coyle further discloses wherein the exchange system includes a moderator system, wherein the moderator system includes a moderator computing system, wherein the exchange system includes switches, wherein the exchange system includes a routing system to provide data transportation services for the buyer through the selected supplier, and wherein the routing system is configured automatically by the exchange system (*column 7, lines 45-63*).

Regarding to claim 8, Coyle further discloses wherein creating includes automatically generating routing data (*column 8, lines 10-35*).

Regarding to claims 9-10, Coyle further discloses wherein the service request specifies a ceiling price for the data transportation services and wherein the buyer specifies whether the ceiling price is made available to the supplier (*column 27, lines 20-50*).

Regarding to claims 12-13, Coyle further discloses wherein the routing data includes first and second endpoints, wherein the first and second endpoints include first and second ports respectively (*column 9, lines 40-65*).

Regarding to claim 14, Coyle further discloses wherein the routing data includes a trunk line specification (*column 9, lines 40-65*).

Regarding to claims 15-16, Coyle further discloses wherein the service request includes a specified closing time for the receipt of incentive data from the supplier and setting by the exchange system a closing time for receiving the incentive data (column 11, lines 45-65).

Regarding to claim 17, Coyle further discloses wherein determining includes determining by the buyer the selected supplier based on the incentive data (*column 27, lines 20-50*).

Regarding to claim 18, Coyle further discloses wherein determining includes determining by a moderating system in the exchange system the selected supplier (*column 7, lines 45-65*).

Regarding to claim 19, Coyle further discloses wherein incentive data includes at least one of economic incentive data, supplier information, and duration of the data transportation services (*column 11, lines 45-65*).

Regarding to claim 20, Coyle further discloses wherein the incentive data includes a time period for which the incentive data is valid (*column 11, lines 45-65*).

Regarding to claim 21, Coyle further discloses wherein the supplier information can be conditionally provided to the buyer (*column 11, lines 20-45*).

Regarding to claim 22, Coyle further discloses providing information regarding the selected supplier to the supplier list (*column 27, lines 35-50*).

Regarding to claim 23, Coyle further discloses providing all or a subset of the incentive data to all or a subset of the supplier list or buyer list (*column 28, lines 3-20*).

Regarding to claim 24, Coyle further discloses providing a view of all or a subset



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of the service requests and incentive data for closed transactions to all or a subset of the supplier list or buyer list (*column 28, lines 55-65*).

Regarding to claim 25, Coyle further discloses providing a view includes providing a view of all or a subset of the open service requests and open incentive data to all or a subset of the supplier list or buyer list (*column 28, lines 55-65*).

Regarding to claim 26, Coyle further discloses wherein open service requests and open incentive data includes partially unfulfilled service requests and incentive data (*column 9, lines 10-17*).

Regarding to claim 27, Coyle further discloses committing the service request after a specified amount of time beyond which the buyer cannot revoke the service request thereby giving the seller a guaranteed sale to compete for (*column 28, lines 35-55*).

Regarding to claim 28, Coyle further discloses receiving resell information as derivative routing data (*column 26, lines 35-40*).

Regarding to claim 29, Coyle further discloses wherein data services include analog and digital information (*column 7, lines 19-22*).

Regarding to claim 30, Coyle further discloses defining a member profile by the buyer or supplier in the exchange system by entering parameters that allow the buyer or supplier to define selection criteria; and wherein determining a selected supplier includes determining a selected supplier from the supplier list based on the incentive data and by applying the buyer's selection criteria against the supplier list and each supplier's selection criteria against the buyer (*column 27, lines 35-50*).

Regarding to claim 31, Coyle further discloses defining a member profile includes entering parameters that allow the buyer or supplier to define selection criteria that includes at least one of supplier identifications, credit limits, and type of transmission line (*column 28, lines 3-20*).

Regarding to claim 32, Coyle further discloses providing a limited view of the buyer list or seller list based on the member profile (*column 28, lines 55-65*).

Regarding to claim 33, Coyle further discloses wherein defining a member profile includes limiting the supplier list through which the selected supplier is determined (*column 27, lines 35-50*).

Regarding to claim 34, Coyle further discloses blocking redefining the member profile to include buyers or sellers limited by the member profile for a protection interval in order to prevent use of the member profile to uncover identities of other companies (*column 28, lines 3-20*).

Regarding to claim 35, Coyle does not disclose querying the exchange system by the at least one supplier or the at least one buyer to search for specific service request parameters or incentive data parameters; whereby the at least one buyer and the at least one supplier can facilitate the submission of service requests and incentive data. However, providing a supplier to search for specific service request from a buyer or a buyer to search for specific service from a seller is well known in the art. Therefore, it would have been obvious to one with ordinary skill in the art to modify Coyle's to incorporate the well-known features above, for the purpose of providing more convenient for the supplier/buyer to find the right service request/service they desired.

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Regarding to claim 36, Coyle further discloses wherein the exchange system includes a billing system (*column 30, lines 60-67, Billing Computer*).

Regarding to claim 37, Coyle further discloses notifying the buyer list or supplier list of a new buyer or supplier (*column 29, lines 15-23*).

Claims 39-48 and 52-73 contain similar limitations found in claims 1-10 and 12-37 above, therefore, are rejected by the same rationale. Moreover, Coyle does not disclose wherein the routing data specifies first and second ports or specifies a trunk line. However, specifying first and second ports or a trunk line for routing data is well known in the art. Therefore, it would have been obvious to one with ordinary skill in the art to modify Coyle's to incorporate the well-known features above, for the purpose of specifying first and second ports or a trunk line for routing data in order to route the data to the specific supplier.

Claims 75-107 contain similar limitations found in claims 1-10 and 12-37 above, therefore, are rejected by the same rationale. Moreover, Coyle further discloses the service request including a specified closing time for receipt of incentive data from the supplier (*column 12, lines 30-35, the bid's effective time*).

### **Conclusion**

9. Claims **1-10, 12-37, 39-48, 52-73, and 75-107** are rejected.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Nga B. Nguyen whose telephone number is

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(571) 272-6796. The examiner can normally be reached on Monday-Friday from 9:00AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on (571) 272-6702.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-3600.

11. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

P.O. Box 1450

Alexandria, VA 22313-1450

Or faxed to:

(703) 273-8300 (for formal communication intended for entry),

or

(571) 273-6796 (for informal or draft communication, please label "PROPOSED" or "DRAFT").

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nga B. Nguyen/  
Primary Examiner, Art Unit 3692

July 27, 2009